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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,481	11/10/2003	Sonya S. Johnson	3712038.00306	5154
29156 K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690	7590 08/11/2010			
EXAMINER				
ROBERTS, LEZAH				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
08/11/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/705,481

**Applicant(s)**

JOHNSON ET AL.

**Examiner**

LEZAH W. ROBERTS

**Art Unit**

1612

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 06 July 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): The rejection under 35 USC 112 -Written Description (New Matter).  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,4,7-11,14,18-20 and 27-33.  
Claim(s) withdrawn from consideration: 21 and 24-26.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612

/Lezah W Roberts/  
Examiner, Art Unit 1612

Continuation of 11. does NOT place the application in condition for allowance because: In regard to Applicant's arguments, Sturtz does not necessarily teach away from Cherukuri and Oppenheimer. Cherukuri requires the combination of menthol and a carboxamide cooling agent because the combination provides a heightened cooling sensation. Cherukuri also discloses that menthol tends to distort flavor notes and render the product bitter when not used in precise amounts (col. 4, lines 8-13). The reference also discloses the use of peppermint in combination with menthol. It would have been obvious to use Erospicata oil to obtain the flavor of peppermint without adding additional menthol in order to better control the amount of menthol that is incorporated into the compositions. Thus one would be able to obtain the desired cooling effect without having to factor in the amount of menthol included by peppermint. One would also be able to control the peppermint flavor without contemplating how the additional menthol from the peppermint oil would affect the composition. In regard to Oppenheimer, it provides the motivation as why one of ordinary skill in the art would want to add warming agent to the compositions of Cherukuri. Although Sturtz teaches menthol irritates nasal, oral and gastrointestinal epithelium, it does not teach away from adding erospicata oil to a composition requiring menthol and having a flavoring agent such as peppermint. It also does not teach away from adding menthol in ingestible products, it teaches there are some negative effects of adding menthol to ingestible products. It also suggests an alternative for peppermint oil when either menthol is not required and a strong peppermint taste is, or a strong peppermint taste is required and a certain amount of menthol is desired such as when menthol is used for its health benefits. Further, since Cherukuri teaches the amount of menthol is important to the taste of the composition, it would be reasonable for one of ordinary skill in the art to substitute peppermint oil with erospicata oil to avoid too much menthol. Additionally, it would be reasonable to use erospicata in place of peppermint to achieve the peppermint taste as well as add a degree of control of how much menthol is used in a composition requiring it. Sturtz does not appear to be teaching away from "any" menthol because the plant itself has menthol. In regard to considering Sturtz as a whole, one of ordinary skill in the art would take in consideration Sturtz's teaching of menthol, but would also recognize the advantages of using Erospicata oil with compositions requiring both menthol and peppermint oil, such as those stated above.